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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/995,151	11/27/2001	Steven L. Rohall	260-137	9916

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ACTON, MA 01720

EXAMINER
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WINTER, JOHN M

ART UNIT	PAPER NUMBER
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3621

MAIL DATE	DELIVERY MODE
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01/10/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

09/995,151

**Applicant(s)**

ROHALL ET AL.

**Examiner**

John M. Winter

**Art Unit**

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 3-5, 9-16, 18 and 20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-5, 9-16, 18 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

- I. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 3-5,9-16,18 and 20 are drawn towards a method for sending and receiving electronic documents, classified in class 705 subclass 1.
  - II. Claims 6-8 and 17 are drawn is drawn towards a method for sending and receiving electronic documents, classified in class 705 subclass 1.

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed in invention I does not require the particulars of the subcombination as claimed in inventions II such as a “graphical representations in a parallel tree environment”.

Examiner notes that it would be a burden to search multiple inventions given their separate status in the art as noted above.

The requirement is deemed proper and therefore made FINAL.

Via paper filed on October 11, 2007 a provisional election was made without traverse to prosecute the of Invention I, claims 3-5,9-16,18 and 20. Affirmation of this election must be

made by applicant in replying to this Office action. Claims 48-55 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. Claims 3-5,9-16,18 and 20 remain pending.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-5, 9-12 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gay, (US Patent 6,792,145) in view of Rackman (US Patent No 5,903,646).

As per claim 3,

Gay ('145) discloses in a computer system operatively coupled to a network and capable of executing a communication process for sending and receiving electronic mail documents, a method comprising:

storing the shadow document in a computer usable memory.(Figure 2)

parsing the original document for selected logistical data comprising any of sender, receiver, original size, subject, date or carbon copies of the original document (Column 7, line 29 – Column 8, line 10)

Gay ('145) does not explicitly disclose creating a shadow document from an original document; identifying one of a parent and child document of the original document and storing a reference thereto in the shadow document. Rackman ('646) discloses creating a shadow document from an original document;(Column 8, lines 15-17; figure 4A) identifying one of a parent and child document of the original document and storing a reference thereto in the shadow document,(Column 8, lines 47-52). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Gay ('145) method with the Rackman ('646) in order to create a redundant data archive so that the document could be retrieved in the event of primary system failing.

Claims 9-12 and 18 are in parallel with claim 3 and are rejected for at least the same reasons.

As per claim 4,

Gay ('145) discloses the method of claim 3 wherein "A" further comprises:  
filtering the original document for selected content.(Figure 2)

As per claim 5,

Gay ('145) discloses the method of claim 3

Gay ('145) does not explicitly disclose wherein the shadow document further comprises selected data from the content of the original document. Rackman ('646) discloses wherein the shadow document further comprises selected data from the content of the original document.

(Figure 4A). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Gay ('145) method with the Rackman ('646) in order to create a redundant data archive using the original content so that the document could be retrieved in the event of primary system failing.

Claims 13-16 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gay, (US Patent 6,792,145) in view of Rackman (US Patent No 5,903,646), and further in view of Newman et al (US Patent Application Publication 2004/0205535)

As per claim 13,

Gay ('145) discloses in a computer system operatively coupled to a network and capable of executing a communication process for sending and receiving electronic mail documents, a method comprising:

storing the shadow document in a computer usable memory.(Figure 2)

Gay ('145) does not explicitly disclose creating a shadow document from an original document upon sending of an original document by the communications process; identifying one of a parent and child document of the original document and storing a reference thereto in the shadow document. Rackman ('646) discloses creating a shadow document from an original document;(Column 8, lines 15-17; figure 4A) identifying one of a parent and child document of the original document and storing a reference thereto in the shadow document,(Column 8, lines

47-52). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Gay ('145) method with the Rackman ('646) in order to create a redundant data archive so that the document could be retrieved in the event of primary system failing.

Gay ('145) does not explicitly disclose presenting an organized plurality of shadow documents with graphical representations in a parallel tree arrangement. Newman et al ('535) discloses presenting an organized plurality of shadow documents with graphical representations in a parallel tree arrangement,(Paragraph 34). It would be obvious to one having ordinary skill in the art at the time the invention was made to modify the Gay ('145) method in view of Newman et al ('535) in order to create a data view that allowed for identification of discrepancies between the documents..

Claim 20 is in parallel with claim 13 and is rejected for at least the same reasons.

As per claim 13,

Gay ('145) discloses the method of claim 3 further comprising:

presenting graphical representations of a plurality of documents in a manner which indicates relationships among the documents.(Figure 5)

As per claim 14,

Gay ('145) discloses the method of claim 13

wherein at least one of the plurality of presented documents is an original document.(Figure 5)

As per claim 15,  
Gay ('145) discloses the method of claim 13  
wherein at least one of the plurality of presented documents is a shadow  
document.(Figure 5)

As per claim 16,  
Gay ('145) discloses the method of claim 1 further comprising:  
resolving the reference in a shadow document to one of the parent and child document,  
and maintaining in memory data identifying a plurality of shadow documents and any parent and  
child documents thereof.(Figure 2)

### ***Response to Arguments***

The Applicants arguments filed on October 17, 2007 have been fully considered.

The pending claims are rejected under 35 U.S.C. 103(a) as being unpatentable over Gay,  
(US Patent 6,792,145) in view of Rackman (US Patent No 5,903,646).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the  
examiner should be directed to John M. Winter whose telephone number is (571) 272-6713. The  
examiner can normally be reached on M-F 8:30-6, 1st Fridays off.



Application/Control Number:  
09/995,151  
Art Unit: 3621

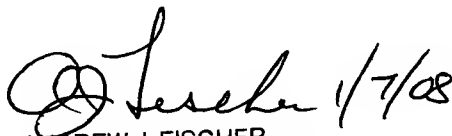
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



John Winter  
Patent Examiner -- 3621



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